

## REMARKS

No claims have been amended and no claims have been canceled in this paper. Applicants ask the examiner to kindly enter this paper, and after entry on the record, claims 1, 2, 7-10, 15, 18, 22, 24-31, 36-39, 44, 47, 51, and 53-58 will be pending in the application.

Applicants have carefully reviewed the arguments presented in the non-final Office Action and respectfully request reconsideration of the claims in view of the remarks below.

### Drawings

The examiner objected to the drawings under 37 C.F.R. 1.83(a) requiring applicants to show the panel without an optical guide and scattering particles ... as set forth in claims 1 and 30. As the examiner is aware, 37 C.F.R. 1.81 requires “(a) The applicant for a patent is required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be patented ....” Applicants respectfully contend in view of the type of panel being used and claimed, and as described in the 1.132 declaration of the inventor that such a panel was known in the art, that a drawing is not necessary for the subject matter sought to be patented.

Also, 37 C.F.R. 1.81 requires a drawing “(c) Whenever the nature of the subject matter sought to be patented admits of illustration by a drawing ....” Applicants believe FIGS. 1 and 2 as filed are already good representations of the claimed invention as both drawings show a display panel without an optical guide or scattering particles. Applicants are not sure as to how else to illustrate a display panel that is missing components such as an optical guide or scattering particles. Is the examiner requiring that applicants add a box with the text “no optical guide or scattering particles” for the conventional features as per 37 C.F.R. 1.83(a) (“The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However,

conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).”)?

For the above reasons, applicants respectfully contend that the drawings as filed fully meet the requirements of 37 C.F.R. 1.81 and 1.83(a). If the examiner would kindly give explicit directions for changes to the drawings, applicants would happily comply.

#### Rejections under 35 U.S.C. § 112

The examiner rejected claims 1-2, 7-9, 15, 18, 22, 24-27, 29-31, 36-38, 44, 47, 51, 53-56, and 58 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description and enablement requirements. In response thereto, applicants have provided for the examiner’s consideration the Rule 1.132 declaration of inventor Sarah M. Lipman.

Inventor Lipman is a person skilled in the art, and her declaration in paragraphs 4-18 explain how a person skilled in the art by reading paragraphs [0050] and [0052] of applicants’ specification would, with respect to the amendments to claims 1 and 30 from the previous response (namely, “a panel without an optical guide and scattering particles therein defining at least one edge”), meet the requirements of 35 U.S.C. § 112, first paragraph. In view of the evidence provided in the 1.132 declaration, applicants’ amended claims contain subject matter that was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention (i.e., the “written description” requirement for a patent application). Further, the 1.132 declaration provides evidence that establishes that the claims as amended contains subject matter that was described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it most nearly connected, to make and/or use the invention (i.e., the “enablement” requirement for a patent application).

The examiner rejected the claims under 35 U.S.C. § 112, second paragraph, as being incomplete for “omitting essential elements.” Applicants respond by respectfully directing the examiner’s attention to the inventor’s 1.132 declaration, at paragraphs 5 and 12, where the inventor explains that the claimed panel is made from well known, off-the-shelf material that inherently has such light-reflecting or -refracting optical qualities due to physical imperfections within the material. Thus, applicants respectfully submit that the claims have not omitted any essential elements, and fully comply with 35 U.S.C. § 112, second paragraph.

Finally, applicants via the 1.132 declaration have attempted to respond directly each of the examiner’s questions set forth on pages 3-7 of the present Office action. Applicants hope that the 1.132 declaration fully addresses the examiner’s concerns over 35 U.S.C. § 112, first and second paragraphs.

#### Rejections under 35 U.S.C. § 103

The examiner rejected claims 1-2, 7-9, 15, 18, 22, 24-27, 29-31, 36-38, 44, 47, 51, 53-56 and 58 under 35 U.S.C. § 103(a) as being unpatentable over Oikawa et al. (U.S. Patent No. 4,320,292) in view of Lipman et al. (WO 03/104965). The examiner rejected claims 10, 28, 39 and 57 under 35 U.S.C. 103(a) as being unpatentable over Oikawa in view of Lipman and further in view of applicants admitted prior art (“AAPA”). These rejections are respectfully traversed.

The examiner agrees that the references do not teach or suggest a panel without an optical guide and scattering particles therein. But the examiner then takes official notice that Lambertian surfaces are typically used to provide scattering effect.

Applicants respectfully note that the examiner, in taking official notice of Lambertian surfaces to modify the prior art, has provided no evidence of such teaching. Applicants respectfully assert that the examiner's official notice that Lambertian surfaces are typically used to provide scattering effect is not based on common knowledge. As such, applicants respectfully request that the examiner produce documentary evidence pursuant to MPEP 2144.03(C).

Furthermore, applicants note that the suggestion of using a Lambertian surface in combination with a non-scattering panel came from applicants' own specification (page 18, lines 27-28). As the examiner is aware, taking the suggestion to use a Lambertian surface from the applicants' own disclosure is impermissible hindsight. ("Applicants may argue that the examiner's conclusion of obviousness is based on improper hindsight reasoning. However, '[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and *does not include knowledge gleaned only from applicant's disclosure*, such a reconstruction is proper.'" MPEP 2145(X)(A), emphasis added.)

For the sake of argument, even if it were known in the art a Lambertian surface could be used for scattering effect, applicants posit that the scattering effect to the edges of a display panel was not known. That is, as the inventor states in the 1.132 declaration at paragraph 18, the scattering properties of simple glass and plastic/acrylic sheets used for displays is well-known, but it is also well forgotten that the quantity/percentage of light that is scattered is so small compared with the amount that passes through the material that persons skilled in the art do not take it into account. The light passing through the panel was key to those skilled in the art, so light scattered to the edges of a panel was not of interest. Thus, even if the scattering of light by a Lambertian surface may have been known, it was not known to use the Lambertian surface to scatter light to be detected by an edge sensor as presently claimed. Applicants, by using scattered light

at the edge of the panel, were proceeding contrary to conventional or accepted wisdom, which is evidence of nonobviousness. MPEP 2145(X)(D)(3).

In view of the foregoing, applicants submit that the examiner has not established *prima facie* obviousness, because (1) the examiner has proffered no evidence to support the official notice of the scattering properties of Lambertian surfaces; and (2) the examiner is using impermissible hindsight based on applicants' own disclosure of using a Lambertian surface to scatter light to an edge sensor. The cited art, without a Lambertian surface, does not meet the *prima facie* obviousness standard.

Finally, persons skilled in the art focused on light passing through a panel, while applicants proceeded to exploit light scattered to the edge of a panel without adding an optical guide or scattering particles, and thus acted contrary to accepted wisdom. Applicants' claimed invention is therefore not obvious in view of the cited art even if combined with a Lambertian surface.

Applicants respectfully disagree with the examiner's other grounds for rejection not specifically addressed above. Applicants have reviewed the prior art made of record but not relied upon and submit that none discloses or suggests the claimed invention.

The Commissioner is authorized to charge Deposit Account No. 06-2426 for any unforeseen fees arising in connection with the filing of this paper. Applicants further invite the examiner to contact the undersigned for any questions arising from this reply.

Respectfully submitted,

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